

## REMARKS

Entry of the foregoing and reexamination and reconsideration of the subject application, pursuant to and consistent with 37 C.F.R. § 112, are respectfully requested in light of the following remarks.

Claims 10-27 are present in this application. Claims 1-9 were previously cancelled. Claims 26 and 27 have been added.

Claim 10 has been amended to delete the phrase "crosslinkable into an adhesive gel by hydrosilylation" from the preamble and to add the phrase "wherein the composition is crosslinkable into a gel by hydrosilylation" into the body of the claim. Claims 11-15 and 21-25 have been amended to delete the phrase "crosslinkable into an adhesive gel by hydrosilylation" from the preamble to have proper antecedent basis from claim 10 from which they depend. Claim 16 has been amended to delete "with" and replace it with "having" and to delete the phrase "crosslinkable into an adhesive gel by hydrosilylation" to have proper antecedent basis from claim 10 from which it depends. Claims 17 and 18 have been amended to delete "adhesive" from the preamble. Claims 19 and 20 have been amended to delete "adhesive" to have proper antecedent basis from the claims from which they depend.

New claims 26 and 27 recite the subject matter of previous claims 17 and 18. No new matter has been added in making these amendments.

### **35 U.S.C. §102(b) prior art rejection**

Claims 10-14, 16-23 and 25 have been rejected under 35 U.S.C. §102(b) as being anticipated by Okami et al. (U.S. Patent No. 5,216,104).

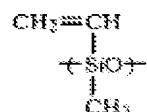
Claims 10-14, 16-23 and 25 are not anticipated by Okami et al. and are allowable.

It is well established that in order to demonstrate anticipation over 35 U.S.C. § 102(b), each feature of the claim at issue must be found, either expressly described or under principles of inherency, in a single prior art reference. See, *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789 (Fed. Cir. 1983).

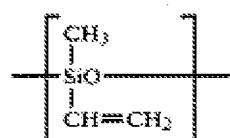
The Office Action maintains that Example 2 of Okami (shown below) anticipates every element of claims 10, 13, 14, 17-23 and 25.

#### EXAMPLE 2

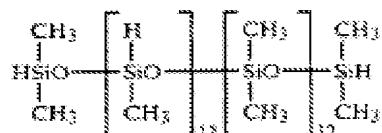
100 parts of dimethylpolysiloxane blocked with dimethylvinylsilyl groups at both terminals, containing one unit of the formula:



in one molecule and having a viscosity of 10,000 cSt, 150 parts of wet process silica having a mean particle diameter of 2  $\mu\text{m}$ , 0.03 part of the same octanol solution of chloroplatinic acid as that used in Example 1, 10 parts of dimethylpolysiloxane containing one unit of the formula:



in one molecule, blocked with trimethylsilyl groups at both terminals and having a viscosity of 100 cSt and 0.05 part of 3-methyl-3-hydroxy-1-butyne as a regulator were blended together homogeneously, followed by the addition of 2.1 parts of an organohydrogenpolysiloxane represented by the average formula:

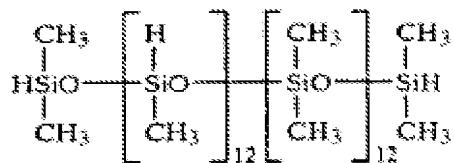


to prepare composition II.

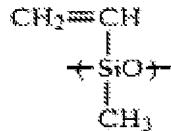
This composition II was examined for physical properties as a rubber and bleeding each in a similar manner to that of Example 1. Further, the composition was molded into a roll having a wall thickness of 3 mm and an outer diameter of 30 mm and this roll was set in a dry copying machine. The diameter of the roll was determined after the passing of 30,000 sheets of paper through the machine. Although the diameter was reduced from 30.00 mm (initial value) to 29.91 mm, the reduction was very slight. The results are given in Table 2.

Okami does not disclose the POS (II) as defined in the instant claim 10, where the definition of POS (II) contains the proviso that the polyorganosiloxane POS (II) comprises at least two X radicals per molecule, where the X radicals are alkenyl radicals having from 2 to 6 carbon atoms.

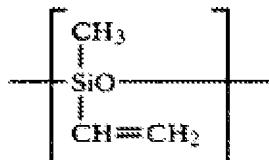
A comparison of the claims to the structures of Example 2 shows that the organohydrogenpolysiloxane having the average formula:



corresponds to POS (1) of the instant claims. The dimethylpolysiloxane blocked with dimethylvinylsilyl groups at both terminals, containing one unit of the formula:



in one molecule, corresponds to POS (III) of the instant claims. For Example 2 to anticipate every element of claim 10, the dimethylpolysiloxane containing one unit of the formula



in one molecule, blocked with trimethylsilyl groups at both terminals would need to correspond to POS (II). However, the definition of POS (II) contains the proviso that the polyorganosiloxane POS (II) comprises at least two X radicals per molecule, where the X radicals are alkenyl radicals having from 2 to 6 carbon atoms. This dimethylpolysiloxane cannot comprise at least two X radicals per molecule, as required by the instant claims. Therefore claim 10 is not anticipated by Okami. Claims 11-14, 16-23 and 25 depend from claim 10 and therefore also not anticipated by Okami.

Applicants respectfully submit that claims 10-14, 16-23 and 25 are not anticipated by Okami et al. and request that the rejection be withdrawn.

### **35 U.S.C. §103(a) Obviousness Rejection**

Claims 11, 12 and 16 have been rejected under 35 U.S.C. §103(a) as unpatentable over Okami et al. (U.S. Patent No. 5,216,104).

Applicant respectfully submits that Claims 10-25 are not obvious over Okami and these claims are allowable.

To establish a *prima facie* case of obviousness, three basic criteria must be met. (MPEP 2143) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Office Action again refers to Example 2 in Okami for making the rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. There is no suggestion or motivation in Okami or in the knowledge generally available to one of ordinary skill in the art to modify Okami to use the POS (II) required by the instant claims. There cannot be any suggestion or motivation in Okami when Example 2 of Okami specifically states that the polysiloxane corresponding to POS (II) contains one unit of the formula. Therefore there is no motivation or suggestion in the cited prior art to modify the invention of Okami to obtain Applicant's invention.

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success. There is no reasonable expectation of success in obtaining the claimed method based on the teachings in Okami. Okami teaches using a polysiloxane corresponding to POS (II) where the polysiloxane contains one unit of the cited formula. One of ordinary skill in the art would recognize that the use of a polysiloxane containing two or more units of the cited formula would provide additional reactive sites which could change the properties of the final composition. Therefore there is no reasonable expectation of success in producing the applicants' invention based on the teachings in the cited prior art.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. It was shown above that Okami does not teach or suggest POS (II). Therefore the cited prior art does not teach or suggest all of the limitations of the instant claims.

Therefore, in consideration of the foregoing, Applicants respectfully submit that claims 10-25 are not obvious over Okami. Applicants therefore request that this rejection be withdrawn.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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